

SEP 13 2007

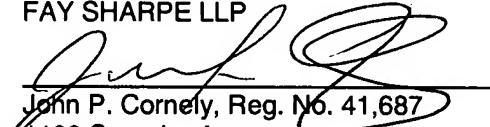
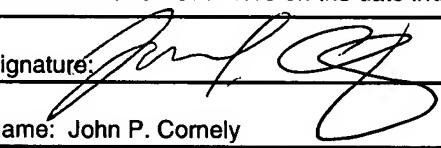
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Substitute for PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

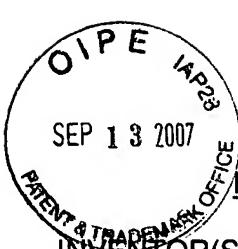
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Doc Code: APRE.REQ

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket No.: <b>PRAZ 2 00011</b>
Application No.: 10/044,630		Filed: January 11, 2002
<b>Title: DYNAMIC NUMBER AUTHENTICATION FOR CREDIT/DEBIT CARDS</b>		
First Named Inventor: Keresman, III, et al.		
Art Unit: 3621	Examiner: Cristina O. Sherr	
<p>Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p><i>Note: No more than five (5) pages may be provided.</i></p>		
I am the		
<input type="checkbox"/> applicant/inventor.		
<input type="checkbox"/> assignee of record of the entire interest See 37 CFR 3.71.		
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/> attorney or agent of record.		
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		
Respectfully submitted, FAY SHARPE LLP  John P. Cornely, Reg. No. 41,687 1100 Superior Avenue Seventh Floor Cleveland, OH 44114-2579 216-861-5582		
Date: September 10, 2007		
NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.		
<input type="checkbox"/> *Total of forms are submitted.		
<b>CERTIFICATE OF MAILING OR TRANSMISSION</b>		
I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being		
<input checked="" type="checkbox"/> deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop None, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.		
<input type="checkbox"/> transmitted to the USPTO by facsimile in accordance with 37 CFR 1.18 on the date indicated below.		
Express Mail Label No.:	Signature: 	
Date: September 10, 2007	Name: John P. Cornely	

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S)

: McCann, et al.

TITLE

: **STREAMLINED SERVICE SUBSCRIPTION  
IN DISTRIBUTED ARCHITECTURES**

APPLICATION NO.

: 10/260,843

FILED

: September 30, 2002

CONFIRMATION NO.

: 7337

EXAMINER

: Aubrey H. Wyszynski

ART UNIT

: 2134

ADVISORY ACTION

: June 14, 2007

ATTORNEY DOCKET NO.

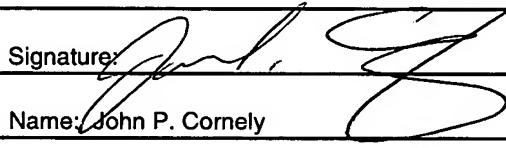
: LUTZ 2 00105  
Case Name/No. McCann 7-8

REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request Pre-Appeal Brief Review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The Applicants respectfully submit the following pages which identify the reasons for requesting Pre-Appeal Brief Review.

Certificate of Mailing or Transmission	
I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being	
<input checked="" type="checkbox"/>	deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
<input type="checkbox"/>	transmitted to the USPTO by facsimile in accordance with 37 CFR 1.18 on the date indicated below.
Express Mail Label No.:	Signature: 
Date: September 10, 2007	Name: John P. Cornely

### The Office Action

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,657,388 to Weiss (“Weiss”).

### Comments/Arguments

The present application is directed to a number and/or code dispenser or token. As disclosed, the numbers or codes dispensed are suitable for use in authentication applications, e.g., associated with commercial and/or other types of transactions. In one exemplary embodiment, the numbers/codes dispensed are “one-time use” numbers/codes. That is to say, after a dispensed number/code is used once, it is no longer valid. Significantly, in exemplary embodiments, the dispenser or token contains and/or stores a plurality of predetermined numbers/codes which are sequentially dispensed on demand. Suitably, the set of numbers/codes are generated by an external device and loaded onto the token or dispenser. In this manner, the token/dispenser is relieved of the computational burden of having to generate each number/code that is dispensed.

Conversely, Weiss is directed to a token which does not store or otherwise contain a plurality of numbers or codes for dispensing. In fact, the explicit preference of Weiss is for the token **12** to “store as little information as possible.” Col. 3, lines 29-30. This is opposed to the present application in which a plurality of numbers/codes are stored in the token/dispenser. In fact, this statement in Weiss teaches away from the present application.

In contrast to the present application, Weiss teaches a token **12** having a memory **18**, which in its simplest case “would contain only a secret user code **22**.” Col. 4, lines 33-34. However, in some embodiments, the memory **18** may also “store a public code **24**, an algorithm **26** and/or a time-varying value **28**.” Col. 4, lines 35-37. In accordance with the teachings of Weiss, the token **12** uses the algorithm and/or other stored elements to generate each number it outputs at the time it is requested. Alternately, an external token processor **14** generates the number each time it is requested. In any event, the token **12** does not contain or store a plurality of predetermined numbers or codes that are dispensed on demand. Note, neither the

secret user code **22** nor the time-varying value **28** nor the public code **24** are ever dispensed (i.e., displayed or otherwise perceivably output). Rather, they are merely factors used to generate the nonpredictable code that is ultimately used for authorization or otherwise output.

With reference now to specific claims, claims 1, 10 and 15 each call for: a set of predetermined numbers, the set including at least a plurality of numbers; a memory for storing the set of numbers; software for selecting and dispensing an unused number from the set; and, a display for displaying the dispensed number. Weiss fails to disclose the foregoing. More specifically, the memory **18** in the token **12** of Weiss does not store a plurality of numbers as claimed which are dispensed from and/or displayed by the token **12**. Accordingly, it is respectfully submitted that claims 1, 10 and 15 distinguish patentably over the prior art, along with claims 2-9, 11-14 and 16-20 that depend therefrom.

Claim 21 is directed to a code dispensing device including storage means for storing a set of codes simultaneously, the set including at least a plurality of codes. A signaling means signals the dispensing device to dispense one of the codes from the set upon each activation of the signaling means, and a display means displays the dispensed codes. Again, Weiss fails to disclose such a code dispensing device. In particular, the memory **18** in the token **12** of Weiss does not simultaneously store a plurality of codes as claimed which are dispensed from and/or displayed by the token **12**. Accordingly, it is respectfully submitted that claim 21 distinguishes patentably over the prior art, along with claims 22-25 that depend therefrom.

In the outstanding Office Action, the Examiner references col. 3, lines 5-10 to support the allegation that Weiss discloses a token which stores a plurality of dispensed numbers or codes. However, the Examiner is misreading and/or misinterpreting the cited passage.

In particular, the Office Action correctly quotes Weiss as follows:

“A time-varying, event varying, use varying or the like value (hereinafter “time-varying value” or “one-time code”) produced or stored at the token processor may also be utilized in generating the nonpredictable coded response.”

While correctly quoted, the passage is nevertheless erroneously interpreted and/or applied to the present claims.

Importantly, the passage refers to “A [singular] time-varying, event varying or the like value … produced or stored at the token processor … .” The claims clearly recite a set of numbers or codes which expressly include a plurality of numbers or codes (i.e., more than one). Accordingly, the singular value referred to in the passage cannot be fairly equated with the claimed set of numbers or codes.

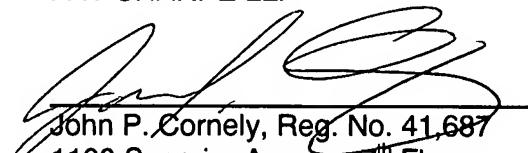
Moreover, in accordance with the claims, the plurality of numbers or codes in the claimed set are ultimately dispensed or displayed, e.g., by the respective device or token. On the contrary, the “time-varying, event varying, use varying or the like value” referred to in the cited passage is not a dispensed number or code, i.e., it is never displayed or output from the token 12. Rather, as expressly stated in the cited passage, the aforementioned value is merely utilized to generate the “nonpredictable code” which is ultimately dispensed or output. Notably, Weiss does not teach storing a plurality of nonpredictable numbers or codes that are ultimately dispensed or output from the token 12.

### Conclusion

For at least the reasons identified above, it is respectfully submitted that the final rejection of claims 1-25 is clearly erroneous. Accordingly, the rejection should be withdrawn and prosecution of the present application reopened. Moreover, it is respectfully submitted that claim 1-25 in fact distinguish patentably over the prior art, and an early indication of the same is therefore earnestly solicited.

Respectfully submitted,

FAY SHARPE LLP



John P. Cornely, Reg. No. 41,687  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582

September 10, 2007  
Date